

Serial No. 10/057,842  
Reply to Office Action of December 29,2005

### **REMARKS/ARGUMENTS**

Claims 1, 7, 11, 12, 14 and 15 are amended to distinctly describe the subject matter of the invention and to incorporate limitations originally appearing in claims 9 and 10. The additional limitations brought into the independent claims place the claims in better condition for consideration on appeal and because they appear in dependent claims as filed, these amendments do not raise any new issues that would require further research by the Examiner. Accordingly, the amendments should be entered under 37 C.F.R. § 1.116.

#### **I. Premature Final Rejection**

The Final Office Action of December 29, 2005 states a rejection of claims 1-15 for the first time based on differing sections of U.S. Patent No. 6,070,191 ("Naredran") and/or U.S. Patent Publication No. 2002/0103913 ("Tawil"). This rejection was not stated anywhere in the prior Office Action mailed February 15, 2005. Specifically, the citations to Naredran Col. 4 lines 16-67 and 44-60 and all citations to Tawil are new and were not stated anywhere in the prior Office Action mailed February 15, 2005. Applicants have not, until now, had an opportunity to address the limitations of claims 1-15 in light of these references/citations and so have been denied a full and fair hearing required by MPEP 706.07.

An Office Action citing new grounds of rejection should only be made final when Applicants' amendment necessitates the new grounds of rejection. The Applicants' amendment of June 13, 2005 reflected an agreement obtained between Applicants and the Examiner overcoming Naredran during an interview as indicated in the interview summary prepared and signed by the Examiner dated June 3, 2005. During that interview, the Examiner and the Applicants discussed other portions of Naredran that were cited against the claims. After discussing the merits of the cited references and the pending claims, the Examiner agreed that a proposed amendment would overcome the cited portions of the art. The

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amendments made to the claims in the subsequent response were made in the direct response to this agreement and were specifically tailored to clarify the claims in a manner suggested and agreed by the Examiner while minimally impacting the scope of the claims. These amendments could not possibly have changed the claims in a manner that would "necessitate" use of a new citation as called for in the MPEP so as to result in a Final Office Action. Since the amendments made to the claims were made with full knowledge and cooperation of the Examiner, they must have been anticipated by the Examiner and could not be grounds for a new search or analysis. Finality of the present Office Action is thus premature.

The cumulative effect of the current action is that the Applicants are forced to address new citations under the constraints of the Office's "after final" practice in their response to this Final Office Action. This is clearly not the intent of the after final practice as described in the MPEP. While the Applicants recognize a new Examiner has been assigned to this case and has reviewed the case *de novo*, the Applicants should not, nonetheless, be penalized for personnel changes resulting in inconsistent, and in this case, directly contradictory opinions. It is respectfully requested that the "made final" status of the December 29, 2005 Office Action be vacated.

## **II. Amendments to Claims**

Applicants herein amend claims 1, 7, 11, 12, 14 and 15 and respectfully traverse the Examiner's pending rejections. No claims are presently canceled and no new claims are presently added. These changes are believed not to introduce new matter, and their entry is respectfully requested. As previously stated, the claims are amended to distinctly describe the subject matter of the invention and to incorporate limitations originally appearing in claims 9 and 10 to the other independent claims. Accordingly, the amendments should be entered under 37 C.F.R. 1.116. The claims have been amended to expedite the prosecution and

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issuance of the application. In making this amendment, Applicants have not and are not narrowing the scope of the protection to which the Applicants consider the claimed invention to be entitled and do not concede, directly or by implication, that the subject matter of such claims was in fact disclosed or taught by the cited prior art. Rather, Applicants reserve the right to pursue such protection at a later point in time and merely seek to pursue protection for the subject matter presented in this submission.

Based on the above amendment and the following remarks, Applicants respectfully request that the Examiner reconsider all outstanding rejections and withdraw them.

**III. Rejection of the Claims under 35 U.S.C. §102(e)**

Claims 1-8 and 11-15 were rejected under 35 U.S.C. §102(e) as being anticipated by U.S. Patent No. 6,070,191 ("Naredran"). The claims as amended possess limitations not disclosed by Naredran. Claim 1 (and claims 7, 9, 11, 12, 14 and 15 in vary language) recites among other things, "a storage area network hub coupled to the raid controller and in communication with the first network attached data storage devices."

The Examiner admits in his response of December 29, 2005 that "Naredran fails to teach, as recited in the independent claims, a storage area network hub connected to the one or more servers, one or more RAID controllers connected to the storage area network hub, wherein the one or more servers communicate with the one or more RAID controllers via the storage area network hub, and a plurality of data storage device resources connected to the one or more RAID controllers."

As the claims as amended possess limitations admittedly not disclosed by Naredran, Naredran fails to anticipate the Applicants' invention. Withdrawal of the rejections is respectfully requested.

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**IV. 35 U.S.C. §103(a) Obviousness Rejection of Claims**

Claims 9 and 10 were rejected under 35 U.S.C. §103(a) as being unpatentable over Naredran in view of Tawil. The Applicants traverse these rejections as well as traverse the likely rejections of the independent claims as amended above. The Examiner turns to Tawil to answer Naredran's failure to teach or suggest RAID controllers used in conjunction with a storage area network hub and a plurality of data storage devices connected to the one or more RAID controllers.

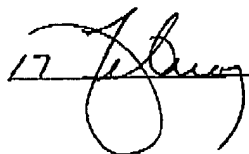
Tawil is not prior art with respect to the Applicants' invention. The limitation disclosing a RAID controller in conjunction with a storage area network hub and a dynamic session redirector was disclosed in United States Provisional Application No. 60/254,474 ("the '474 application") which was filed December 8, 2000. The Applicants properly claimed priority to the '474 application under 35 U.S.C. § 119(e) as is reflected by the filing receipt. As Tawil was filed on January 26, 2001, it is not prior art. Applicants submit that the claims as currently amended are patentable over Naredran in view of Tawil. Withdrawal of the rejections is respectfully requested.

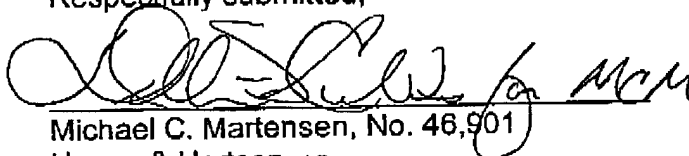
In view of all of the above, the claims are now believed to be allowable and the case in condition for allowance which action is respectfully requested. Should the Examiner be of the opinion that a telephone conference would expedite the prosecution of this case, the Examiner is requested to contact Applicants' attorney at the telephone number listed below.

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No fee is believed due for this submittal. However, any fee deficiency associated with this submittal may be charged to Deposit Account No. 50-1123.

Respectfully submitted,

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